

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of May 6, 2009 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

Claims Rejections – 35 USC § 103

Claims 1-4, 22-25, and 29-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application 2006/0019667 to Hicks, III (hereinafter Hicks), in view of U.S. Published Patent Application 2002/0006797 to Virtanen (hereinafter Virtanen). Claims 5-7, 26-28, and 33-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Virtanen, and further in view of U.S. Patent 6,600,734 to Gernert, *et al.* (hereinafter Gernert).

Applicants maintain that Hicks is not available as a prior art reference because the present invention predates the earliest effective date 6/6/2003 of Hicks. Therefore, Applicants submit that all rejections in connection with Hicks are moot.

According to the Declarations, the Invention Disclosure, and the supporting documents submitted on 2/12/2008 as well as additional supporting documents submitted with this response, Applicants conceived their invention at least as early as on 3/17/2003 and diligently pursued the present invention to its reduction to practice from a date prior to the earliest effective date of Hicks.

It was asserted in the Office Action that no supporting document has been produced to show due diligence from the date prior to 6/6/2003 (Hicks' earliest effective date) to the Exhibit A date of 9/25/2003 related to the instant application. Applicants

submit herewith the following additional supporting documents which are fall within this time period:

1. Search report prepared by an outside searcher at the request of IBM and received by IBM on 6/17/2003;
2. A letter dated 6/20/2003 from an IBM in-house attorney to the inventor Tom Creamer, requesting written comments to the search results.

The inventor Tom Creamer reviewed the search results and provided comments on 9/25/2003, which is shown in Exhibit A submitted 2/12/2008.

These documents indicate the continuing effort of the IBM in-house attorneys in diligently reviewing and evaluating the submitted invention disclosure in order to determine whether an application should be filed. The search report represents only the culmination of the search process, and evidences ongoing efforts before the date of the actual reporting letter. Similarly, the request to the inventors to review these results represents only the beginning of yet another phase of Applicants' ongoing efforts. The inventors diligently cooperated with this effort.

It is noted that the inventors are full time employees of IBM and are not required to put aside other projects to work only on the instant application. It is, therefore, believed that the time spent by the inventors in reviewing and commenting on the search results is reasonable. According to MPEP 2138.06, the diligence relates to reasonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney drop all other work and concentrate on the particular invention involved." *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974).

In consideration of the above, Applicants respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

NOVAK DRUCE + QUIGG LLP

Date: August 6, 2009

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- Search Request No: BOC8-03-0050 (Patentability)
- Search Request For: Richard Tomlin

DESCRIPTION:

This invention brings cellular and 802.11 networks together into a unified solution by using the cellular control channel to communicate the IP address of an 802.11 radio embedded within a cellular phone. This IP address tells the cellular network to route voice data to the respective cellular phone via a VOIP gateway attached to the Internet.

FIELD OF SEARCH

| CLASS | SUBCLASSES |
|-------|--------------------------------|
| 370 | 401, 466 |
| 455 | 422, 422.1, 462, 466, 469, 555 |
| 709 | 249 |

DATABASES

| | | | | | |
|---|------------|---|------|---|-------|
| X | PLUSPAT | X | DOSS | X | TDBS |
| X | INSPEC | | WPIL | | JAPIO |
| | LITERATURE | | | | |

RELATED ART

| PATENT NUMBER | PATENT NUMBER | PATENT NUMBER | IBM-TDB | LITERATURE |
|---------------|---------------|---------------|---------|------------|
| 6411632 | | | | |
| 6289214 | | | | |
| | | | | |
| | | | | |

BACKGROUND ART

| PATENT NUMBER | PATENT NUMBER | PATENT NUMBER | IBM TDB | LITERATURE |
|---------------|---------------|---------------|---------|------------|
| 5956331 | | | | |
| 6535730 | | | | |
| 6292891 | | | | |
| | | | | |
| | | | | |

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IP LAW DEPT
BOCA RATON

How does each of the Related Art references correspond to the Search Feature? (Claims if Validity/Clearance)

Patent 6411632 relates to a network hub for interconnecting a cellular telephone network with a wireless office environment having TCP/IP protocol. Mobile stations include an IP address for the wireless network.

Patent 6289214 discloses a cellular radiotelephone system in which communication takes place between a central cellular operator system and a cellular radio exchange. A TCP/IP communications protocol uses an IP address to route messages between networks.

What features does the Background Art provide:

Patent 5956331 – cellular radio system which connects networks through a gateway computer located in each radio local area network.

Patent 6535730 – use of a standard cellular telephone as a wireless extension of a desktop phone while in the proximity a miniature radio base station.

Patent 6292891 – cellular radio network of interest.

What features were not found?

Comments:

Signature

J. A. Kunkle

Date returned to WAIP

6/6/03

IBM CONFIDENTIAL

PREPARED BY IBM ATTORNEY

June 20, 2003

TO: Tom Creamer

FROM: Richard A. Tomlin
Richard Tomlin/Boca Raton/IBM
Intellectual Property Law Department
8051 Congress Avenue, Internal Zip 4041
Boca Raton, Florida 33487

SUBJECT: Invention Disclosure BOC8-2003-0050
Using a Cellular Control Channel to Roam between 802.11 Networks

Enclosed are the results of a patentability search conducted regarding the subject disclosure.

Please review the results with a view toward identifying differences in the problem solved and the solution relative to what is taught in the references that go beyond ordinary engineering.

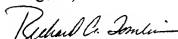
In your review, please consider carefully the possible combination of the teaching in the various cited art in deciding what it would suggest to one of ordinary skill in the art.

You should also look to the claims to consider whether they present any concerns about IBM's freedom to use the subject matter of your disclosure. If you have questions or concerns about the claims or how to interpret them, please contact me.

Once you have considered the results, please provide a concise written description of the differences between each of the cited related art and your invention, with particular attention given to the inventive features of your disclosure which do not appear in the art.

If you have any questions about the search results, please contact me.

Regards,


Richard A. Tomlin

cc: Neil Katz
Vic Moore

Enclosures